

REMARKS

This paper responds to the Office Action dated January 9, 2010. Claims 30, 35, 38, and 53 are amended herein. No claims are canceled, and no claims are added. As a result, claims 30-53 remain pending in this application.

The Rejection of Claims Under § 103

Claims 30-39 and 53 were rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over Herzberg et al. (European Patent Application 0717337, hereinafter “Herzberg”) in view of Holliman et al. (U.S. Patent Application Publication 2002/0116533, hereinafter “Holliman”). A determination of obviousness under § 103 requires a factual showing that “the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains.”¹ “The question of obviousness is resolved on the basis of underlying factual determinations including (1) the scope and content of the prior art, (2) any differences between the claimed subject matter and the prior art, (3) the level of skill in the art, and (4) where in evidence, . . . secondary considerations.”² According to the U.S. Circuit Court of Appeals for the Federal Circuit (CAFC), when determining whether a claim is obvious, the Examiner must make “a searching comparison of the claimed invention – including **all its limitations** – with the teaching of the prior art.”³ “**All words** in a claim must be considered in judging the patentability of that claim against the prior art.”⁴ Applicants respectfully submit that a determination of obviousness under § 103 is not established for the reason that the scope and content of the cited references, even if combined, do not teach or suggest all claimed elements or support rational inferences that one skilled in the art reasonably would be expected to draw to reach all claimed elements.

¹ *Graham v. John Deere*, 383 U.S. 1, 17, 148 U.S.P.Q. 459, 467 (1966).

² *Graham*, 383 U.S. at 17-18, 148 U.S.P.Q. at 467, *KSR Int'l Co. v. Teleflex, Inc.*, 550 U.S. 398, 406-7, 82 U.S.P.Q.2d 1385, 1390 (2007), cited in *Ex parte Frye*, Appeal No. 2009-006013 (BPAI 2010) (precedential).

³ *In re Ochiai*, 71 F.3d 1565, 1572 (Fed. Cir. 1995), emphasis added; see also *Ex Parte Wada and Murphy*, Appeal No. 2007-3733 (BPAI 2008).

⁴ *In re Wilson*, 424 F.2d 1382, 1385, 165 U.S.P.Q. 494, 496 (CCPA 1970), emphasis added; see MPEP § 2143.03.

Each of independent claims 30, 35, 38, and 53 recites, in part, “second data processing **instructions, when executed by a computer language interpreter . . . , configuring the computer language interpreter to request [an] access to a memory.**” The Office Action cited column 8, lines 5-15 of Herzberg as allegedly teaching the second data processing **instructions** by discussing a “signature **token.**”⁵ While the cited passage of Herzberg indeed discusses a “[s]ignature token [that] includes a header and data records,”⁶ a token is not the same as instructions, and a signature token is not the same as data processing instructions executable by a computer language interpreter. Similarly, a header is not the same as instructions, and data records are not the same as instructions. The same cited passage of Herzberg states that a “signature token includes [a] digital signature.”⁷ A digital signature is not the same as instructions. To one of ordinary skill in the art, mere discussion of a **token** does not teach or suggest executable data processing **instructions**, let alone data processing instructions that, when executed by a computer language interpreter, configure the computer language interpreter to request an access to a memory. As a result, the discussion in Herzberg of a **signature token** fails to teach or suggest the **second data processing instructions**, as recited in independent claims 30, 35, 38, and 53.

The Office Action cited column 16, lines 5-15 of Herzberg as allegedly teaching “second data processing **instructions, when executed by a computer language interpreter . . . , configuring the computer language interpreter request an access to a memory.**”⁸ The cited passage of Herzberg merely states that “a floppy disk containing data processing system executable instructions may be inserted into a floppy disk drive in the data processing system; or a ROM containing data processing system executable instructions may be connected to the data processing system via a card or adapter connected to an I/O slot.”⁹ While the cited passage of Herzberg mentions “executable instructions,” these executable instructions are merely being **contained** by a floppy disk or a ROM. Nothing in the cited passage of Herzberg mentions data processing instructions that, when executed by a computer language interpreter, **configure the**

⁵ Office Action at 3, emphasis added.

⁶ Herzberg at column 8, lines 9-10.

⁷ *Id.* at column 8, line 15, reference numerals omitted.

⁸ Office Action at 3.

⁹ Herzberg at column 16, lines 6-11.

computer language interpreter to request an access to a memory. Moreover, the floppy disk of Herzberg and the ROM of Herzberg have nothing to do with the “signature token” of Herzberg previously cited by the Office Action as allegedly teaching the “second data processing instructions” recited in the claims. Hertzberg fails to describe any connection between the signature token and these executable instructions. As a result, the mere mention of executable instructions in Herzberg fails to teach or suggest second data processing instructions that, when executed by a computer language interpreter, configure the computer language interpreter request access to a memory.

Moreover, the Federal Circuit has stated that “rejections on obviousness cannot be sustained with mere conclusory statements; instead, there must be some **articulated reasoning with some rational underpinning** to support the legal conclusion of obviousness.”¹⁰ While the Office Action referred to passages in Herzberg, the Office Action contained no rational argument providing a legal nexus between the referenced passages and the claim elements alleged to be taught by the referenced passages. Accordingly, the assertions in the Office Action that Herzberg teaches these claim elements are mere conclusory statements that do not sustain the rejections of Applicants’ claims.

The remainder of Herzberg is similarly silent with respect to “second data processing **instructions, when executed by a computer language interpreter . . . , configuring the computer language interpreter to request [an] access to a memory.**” The claim element shown to be absent from Herzberg is similarly absent from Holliman. As a result, the combination of Herzberg and Holliman fails to teach or suggest second data processing instructions that, when executed by a computer language interpreter, configure the computer language interpreter request access to a memory.

Furthermore, each of independent claims 30, 35, 38, and 53 recites, in part, “obtain[ing] a **cryptographic value of the second data processing instructions; [and] determin[ing] an authenticity of the second data processing instructions by using the cryptographic value.**”

¹⁰ *KSR Int’l Co. v. Teleflex, Inc.*, 550 U.S. 398, 82 U.S.P.Q.2d 1385 (2007), quoting *In re Kahn*, 441 F.3d 977, 988, 78 U.S.P.Q.2d 1329, 1337 (Fed. Cir. 2006), emphasis added; see also MPEP §§ 2141(III) and 2142.

Because the combination of Herzberg and Holliman fails to teach or suggest second data processing instructions that, when executed by a computer language interpreter, configure the computer language interpreter request access to a memory, the combination of Herzberg and Holliman consequently cannot to teach or suggest obtaining a cryptographic value of such second data processing instructions. In addition, because the combination of Herzberg and Holliman cannot teach or suggest obtaining this cryptographic value, the combination of Herzberg and Holliman furthermore cannot teach or suggest determining an authenticity of such second data processing instructions by using the cryptographic value. Accordingly, the combination of Herzberg and Holliman are silent with respect to these claim elements.

For at least these reasons, the scope and content of Herzberg and Holliman, even if combined, do not teach or suggest all claimed elements or support rational inferences that one skilled in the art reasonably would be expected to draw to reach all claimed elements. As a result, a determination of obviousness is not established with respect to any of independent claims 30, 35, 38, and 53, and their respective dependent claims, including claims 31-34, 36-37, and 39. Moreover, the dependent claims may each be patentable based on limitations recited therein. Thus, Applicants respectfully request that these rejections be reconsidered and withdrawn and that the claims be allowed.

Claims 40-52 were rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over Kocher et al. (U.S. Patent 6,289, 455, hereinafter “Kocher”) in view of Holliman. Applicants respectfully submit that a determination of obviousness under § 103 is not established for the reason that the scope and content of the cited references, even if combined, do not teach or suggest all claimed elements or support rational inferences that one skilled in the art reasonably would be expected to draw to reach all claimed elements.

Each of independent claims 40 and 46 recites, in part, “determin[ing] a **security risk of the playback device.**” Similar claim language is recited in each of independent claims 51 and 52. The Office Action cited column 12, lines 15-25 of Kocher as allegedly teaching this claim

element by discussing an “audit process” that allegedly “teaches accessing security.”¹¹ Prior art must be considered **in its entirety**,¹² and according to Kocher, an “audit” is of “the **user’s usage** [of content].”¹³ Accordingly, within Kocher, an audit process is a process to audit a user’s usage of content. Auditing a user’s usage of content is not the same as determining a security risk of a playback device, of an apparatus, or of a machine. The cited passage of Kocher merely discusses “processes for auditing and clearing audit data,”¹⁴ with no mention whatsoever of security or risk, let alone determination of a security risk.

Moreover, each of independent claims 40, 46, 51, and 52 recites, in part, “**identify[ing]** second **data processing instructions as a software countermeasure associated with the security risk**, the identifying being **based on the security risk**.” The Office Action cited column 11, lines 30-40 of Kocher as allegedly teaching this claim element. The cited passage of Kocher merely discusses “stor[ing] the result (the rights key) in the protected memory . . . deriving [content decryption keys] using rights keys stored in the . . . protected memory.”¹⁵ A rights key is not the same as data processing instructions. Similarly, content decryption keys are not the same as data processing instructions. Moreover, storing a rights key is not the same as identifying data processing instructions as a software countermeasure. Likewise, deriving content decryption keys does not constitute identifying data processing instructions as a software countermeasure. Applicants note that each of independent claims 40, 46, 51, and 52 further recites, in part, “**execution** of the second data processing instructions.” Nothing in Kocher suggests that the rights keys or the content decryption keys are executable. Accordingly, the cited passage of Kocher fails to make any mention of identifying instructions as a software countermeasure associated with a security risk, based on the security risk.

¹¹ Office Action at 7 and 12.

¹² *W.L. Gore & Associates, Inc. v. Garlock, Inc.*, 721 F.2d 1540, 220 U.S.P.Q. 303 (Fed. Cir. 1983), *cert. denied*, 469 U.S. 851 (1984); see MPEP § 2141.02(VI), (“**A prior art reference must be considered in its entirety, i.e., as a whole, including portions that would lead away from the claimed invention,**” emphasis added).

¹³ Kocher at column 2, line 65 - column 3 line 2, “the content provider later **audits the user’s usage** and determines the appropriate fees to charge,” emphasis added.

¹⁴ *Id.* at column 12, lines 7-8.

¹⁵ *Id.* at column 11, lines 31-38.

Furthermore, the assertions in the Office Action that Kocher teaches these claim elements are mere conclusory statements with no **articulated reasoning** or **rational underpinning** to support the legal conclusion of obviousness. Although the Office Action referred to passages in Kocher, the Office Action contained no rational argument providing a legal nexus between the referenced passages and the claim elements alleged to be taught by the referenced passages. As a result, the assertions in the Office Action do not sustain the rejections of Applicants' claims.

The remainder of Kocher is similarly silent with respect to "determin[ing] a security risk of an apparatus" and with respect to "identify[ing] the second data processing instructions as a software countermeasure associated with a security risk, the identifying being based on the security risk." These claim elements shown to be absent from Kocher are similarly absent from Holliman. As a result, the combination of Kocher and Holliman fails to teach or suggest these claim elements.

For at least these reasons, the scope and content of Kocher and Holliman, even if combined, do not teach or suggest all claimed elements or support rational inferences that one skilled in the art reasonably would be expected to draw to reach all claimed elements. As a result, a determination of obviousness is not established with respect to any of independent claims 40, 46, 51, and 52, and their respective dependent claims, including claims 41-45 and 47-50. Moreover, the dependent claims may each be patentable based on limitations recited therein. Thus, Applicants respectfully request that these rejections be reconsidered and withdrawn and that the claims be allowed.

CONCLUSION

Applicants respectfully submit that the claims are in condition for allowance, and notification to that effect is earnestly requested. The Examiner is invited to telephone the undersigned at (408) 406-4855 to facilitate prosecution of this application.

If necessary, please charge any additional fees or deficiencies, or credit any overpayments to Deposit Account No. 19-0743.

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CERTIFICATE UNDER 37 CFR 1.8: The undersigned hereby certifies that this correspondence is being filed using the USPTO's electronic filing system EFS-Web, and is addressed to: Mail Stop Amendment, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450 on this 7th day of April, 2010.

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